

REMARKS

Claims 1-3, 5-8 and 29 are pending in the application.

Issues under 35 USC § 103(a)

Claims 1-3, 5-8 and 29 have been rejected under 35 USC § 103(a) as being unpatentable over Tetsuo et al. (EP 1065234 A2) in view of Nishizawa et al. (US Patent Application 2006/0123564). This rejection is respectfully traversed. Reconsideration and withdrawal thereof are requested.

Nishizawa et al. (US Patent Application 2006/0123564)

Applicants assert that Nishizawa et al. is not valid as prior art for the following reasons. The present application was filed on October 13, 2005 and claims priority to the PCT international filing date of April 14, 2003. Nishizawa has a U.S. publication date of June 15, 2006 and claims priority to PCT Application No. PCT/JP/03/15153 filed on November 27, 2003, which is after Applicants' priority date. Additionally, PCT/JP/03/15153 was published in the Japanese language. Therefore, under 35 USC § 102(e), Nishizawa is available as prior art only as of June 15, 2006 and not as of the PCT application filing date. Accordingly, Nishizawa is not prior art against the instant application and is improperly applied in this rejection.

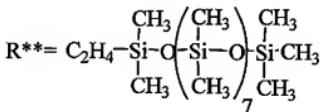
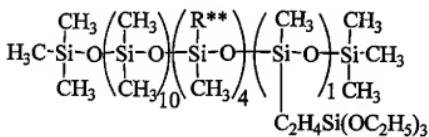
Since the only remaining rejection of all of the instant claims relies on a combination of Tetsuo et al. and Nishizawa et al., and since Nishizawa is not appropriately applied in the rejection, it follows that the teachings of Tetsuo et al. alone are not sufficient to demonstrate a *prima facie* case of obviousness. However, Applicants can further distinguish the cosmetic of the instant invention from that of Tetsuo et al.

Tetsuo et al. (EP 1065234 A2)

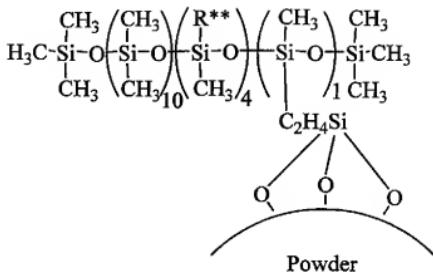
The invention of Tetsuo et al. is directed to a silicone for powder treatment. The cosmetic described in Tetsuo contains a powder which has been surface-treated with the silicone. The surface-treatment is performed by:

1. adding the silicone diluted with toluene to the powder,
2. heating the powder to distill off the toluene, and
3. stirring the powder at 150°C for 3 hours to effect the baking treatment as described at page 12, paragraph [0091].

This treatment causes the silicone to form a linkage with the powder surface which structurally changes the silicone. For example, when the following silicone:



is surface-treated according to the method described in Tetsuo et al., the ethoxy groups decompose to form a linkage with the -OH groups of the powder, such as silica or adsorbed water, and the following silicone is formed:



Thus, the cosmetic described in Tetsuo et al. does not contain silicone unaltered by a surface treatment step.

The Examiner has supported a finding of obviousness by asserting that the skilled artisan would be motivated to use the composition of Tetsuo et al. in a shampoo since excellent storage stability is taught by Tetsuo et al. However, since Tetsuo teaches only a cosmetic containing a powder which has been surface-treated with silicone, and since Tetsuo fails to teach a method of conditioning hair by applying an organopolysiloxane hair treatment composition according to the instant invention, then the storage stability feature of Tetsuo et al. could only be expected to apply to cosmetics as described in Tetsuo et al. and could not be expected to apply to cosmetics as used in the methods instantly claimed. There is no motivation in Tetsuo et al. for the skilled artisan to prepare a completely different cosmetic with the assumption that it would also exhibit storage stability and therefore be suitable as a hair conditioning agent. Absent the requisite motivation and expectation of success, one of ordinary skill in the art would not find Applicants' invention obvious over Tetsuo et al.

Applicants further assert that even if the silicone of Tetsuo et al. was able to exist in its original, unaltered, chemical form on the powder surface, the storage stability feature could not be realized without baking the powder at 150°C for 3 hours. This baking step (and thereby the stabilizing step) cannot be applied to the hair being treated with the cosmetic.

Finally, the deficiencies of Tetsuo et al. cannot be overcome by the combination with Nishizawa et al. since Nishizawa fails to qualify as prior art for the reasons set forth above.

Inasmuch as Tetsuo et al. fails to teach the instant method of conditioning hair by applying an organopolysiloxane hair treatment composition to the hair, and since Nishizawa et al. is not prior art and therefore cannot be used as a secondary reference in this rejection, Applicants respectfully request that the rejection under 35 USC § 103(a) of claims 1-3, 5-8 and 29 over Tetsuo et al. in view of Nishizawa et al. be withdrawn.

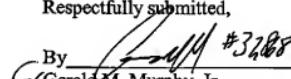
In view of the above amendment, applicant believes the pending application is in condition for allowance.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact, Gerald M. Murphy, Reg. No. 28,977, at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.147; particularly, extension of time fees.

Dated: April 29, 2008

Respectfully submitted,

By 
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